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Chunlin Tao

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3274

67374

7590

03/05/2008

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EXAMINER

GROSS, CHRISTOPHER M

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ADVISORY ACTION

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In accordance with MPEP 803.02, should applicant overcome a rejection - by amending a claim set - to exclude species anticipated or rendered obvious by the prior art, the search concerning amended claims will need to be extended to the extent necessary to determine patentability. Said search extension constitutes an additional consideration and/or search. See MPEP 714.13. Here, the proposed amendment filed 1/28/2008 includes new claims 15-28, which require further search and consideration.

New claims 15-28 also do not place the application in better form for appeal by materially reducing or simplifying the issues for appeal because the limitation set forth in new claim 15 directed to A-A not being part of a cyclic disulfide has not been addressed in the prosecution history thus far.

Furthermore, there is no reason why the proposed amendments were not presented earlier in prosecution. See 37 CFR 1.116 (b)(3).

In light of the fact that the proposed amendments, filed 1/28/2008, after final rejection will not be entered, Applicant's arguments filed 1/28/2008 (see p 9-10) are rendered moot.

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Applicant argues not all elements are taught.

Applicant's arguments have been fully considered but they are not deemed persuasive for the following reasons.

First applicant argues, see p 8 (1/28/2008) that the formula set forth in claim 1 represents a chemical structure, which limits the claimed subject matter such that MFS may not be 'directly attached' to AG.

In this regard, the examiner submits that MFS-A-A-AG does not constitute an bona fide chemical structure for the following reasons. As set forth in claim 1, MFS, A and AG are not elements found on the periodic table. Additionally, MFS and AG do not constitute any art-recognized chemical functionality, such as the t-butyloxycarbonyl protecting group in peptide synthesis, commonly abbreviated 'Boc.'

Similarly, the lines connecting each of the elements MFS, and AG can not be taken as representing bonds in that the valency of each MFS A and AG can not be discerned, not being atoms or an art-recognized chemical functionality. Without any electronic limitations regarding MFS, A and AG, set forth in claim 1, the configuration of each of MFS, A and AG, is considered broad enough to include species such as shown in figure 5C of Marks et al (see below).

Second applicant argues, see p 8 paragraph 4 through p 9 second full paragraph, structure 5C of Marks et al may be interpreted in many ways and has invited the examiner to specifically point out which features of figure 5C correspond to formula 1 in claim 1. In this regard, to clarify the record, the examiner has annotated figure 5C of Marks et al below.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "monopodal" attachment) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Applicant's amendment to the specification on 9/10/2007 indicating the present application as being a divisional, rather than a continuation of application 09/847,113 05/01/2001 (now PAT 6,753,143) is hereby entered. The examiner regrets any confusion raised in the final Office Action mailed 11/28/2007.

Nevertheless, in order to advance future prosecution of the present application, the following comments are noted. Newly submitted proposed claims 15-28, directed to A-A not being part of a cyclic disulfide appear likely to be sufficient to overcome the 35 USC 102 rejection over Marks et al of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Gross whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Douglas Schultz can be reached on 571 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M Gross
Examiner
Art Unit 1639

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/Mark L. Shibuya, Ph.D./

Primary Examiner, Art Unit 1639